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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,539	12/03/2003	George W. McClurg	1823.0820003	3200

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EXAMINER

ROBINSON, MARK A

ART UNIT PAPER NUMBER

2872

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,539

Applicant(s)

MCCLURG ET AL.

Examiner

Mark A. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4-7, 14 and 16-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 8-13, 15 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spherical surface of claim 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR

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1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 26 calls for the first portion to have either a "quasi-triangular" or "parallelogram" cross-sectional shape. However, these terms do not have support in the disclosure as originally filed and constitute new matter.

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Additionally, it is unclear what applicant intends to be encompassed by "quasi-triangular." Further, the first portion(310) shown in fig. 3 does not appear to have a parallelogram cross-sectional shape, and thus this term would appear to be a misdescription of the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,9-13,15 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Albada (US 2146662).

Albada shows a prism(2) including a non-planar spherical first portion (the curved surface) which surrounds and is symmetrical around a central axis (an axis of symmetry) and a planar second portion (the flat surface) which is coupled at an angle to the first portion. Note regarding claims 9 and 10 that the material is glass. Note regarding claims 13 and 15 that the first portion includes a target section (the curved surface), but "configured to be used..." or "configured to receive" are

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statements of intended use which do not further limit the present invention structurally. Since Albada's prism is capable of such use, it anticipates these limitations.

The preamble recitation of "used in a system..." is a statement of intended use which has not been given significant patentable weight since it does not further limit the present invention structurally. Further, it should be noted that Albada's element(2) constitutes a prism in a similar manner as would applicant's element(108), especially when the first portion is spherical as set forth in claim 12.

The limitations of claim 26 are met as discussed above. Note also that since "quasi-triangular" has not been delimited in any way, Albada's prism(2) is seen to include a cross-sectional shape satisfying this limitation.

6. Claims 1,3,9-11,13,15 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Willson (US 1501979).

Willson shows a glass prism(20--see also p.1 line 75) including a non-planar (curved) conical first portion(35) which surrounds and is symmetrical around a central axis of symmetry(A), and one of a non-planar or planar second portion (figs. 3,8 or 9) which is coupled at an angle to the first portion. Note that the first portion includes a target section

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and is "configured" to receive a body portion (a portion of the user's hand). Note regarding claims 13 and 15 that "configured to be used..." or "configured to receive" are statements of intended use which do not further limit the present invention structurally. Since Willson's prism is capable of such use, it anticipates these limitations.

The preamble recitation of "used in a system..." is a statement of intended use which has not been given significant patentable weight since it does not further limit the present invention structurally.

The limitations of claim 26 are met as discussed above. Note also that a "quasi-triangular" cross-sectional shape is shown in figs. 3, 8 or 9.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Albada in view of applicant's admission of the prior art.

Regarding claim 8, Albada does not teach the first portion to include a protective coating. However, such an arrangement is known as admitted by applicant on page 9 of the specification. It would have been obvious to the ordinarily skilled artisan at the time of invention to include a protective coating in Albada's device in order to provide the prism with protection.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Willson in view of applicant's admission of the prior art.

Regarding claim 8, Willson does not teach the first portion to include a protective coating. However, such an arrangement is known as admitted by applicant on page 9 of the specification. It would have been obvious to the ordinarily skilled artisan at the time of invention to include a protective coating in Willson's device in order to provide the prism with protection.

Response to Arguments

10. Applicant's arguments filed 7/26/05 have been fully considered but they are not persuasive.

Applicant has argued against the objection to the drawings by stating that the spherical surface of claim 12 is discussed in the specification.

However, the problem lies with the drawings and not with the specification. The first portion(310) having a spherical shape is not shown in the drawings. Thus, the objection to the drawings stands.

Applicant has also argued that the references do not meet the limitations of the claims as amended.

However, the claims as amended are met by the references in the manner set forth above in the rejections.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this

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action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MR

8/23/05


MARK A. ROBINSON
PRIMARY EXAMINER